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IN THE

**Supreme Court of the United States**

**October Term, A. D. 1938**

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**No. 603**  
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**MONTGOMERY WARD & COMPANY, INC.,**  
an Illinois corporation,

*Petitioner,*

*vs.*

**THE TOLEDO PRESSED STEEL COMPANY,**  
an Ohio corporation,

*Respondent.*

\_\_\_\_\_  
**BRIEF FOR PETITIONER.**  
\_\_\_\_\_

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**BRIEF FOR PETITIONER.**

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**I.**

**OPINION OF THE COURT BELOW.**

The opinion of the United States Circuit Court of Appeals for the Second Circuit holding valid and infringed patent to Withrow et al. No. 1,732,708, was rendered November 7, 1938 (R. 447). A petition for rehearing was denied December 5, 1938 (R. 471). The opinion is reported in 99 F. (2nd) 806.

**II.**

**JURISDICTION OF THIS COURT.**

1. The jurisdiction of this Court is based on Section 240 of the Judicial Code as amended by the Act of February 13, 1926, 28 U. S. C. A. Sec. 347. The jurisdiction of the District Court arose through a suit brought under the patent statute.

2. The original date of the judgment below was November 7, 1938 (R. 447). A petition for rehearing (R. 455-470) was filed November 19, 1938, within the time provided by the rule of the Circuit Court of Appeals, and rehearing was denied December 5, 1938 (R. 471); a petition for a writ of certiorari was filed January 19, 1939 and certiorari was allowed February 6, 1939. There is a conflict in decisions between the Second Circuit in the decision below and the decision of the Circuit Court of Appeals for the Sixth Circuit in *Standard Parts, Inc. v. The Toledo Pressed Steel Co.*, 93 F (2nd) 336, which held the patent in suit void for want of invention.

### III.

#### STATEMENT OF THE CASE.

##### a. The Patent in Suit.

Withrow and Close, No. 1,732,708, the patent in suit, purports to cover a burner. Claims 2, 5, 11 and 12 are sued on.

The device described in the claims and exemplified in respondent's commercial structures, comprises a drawn sheet metal torch body normally sized to contain something more than a quart of kerosene, having an opening at the top for a wick, the wick being usually from five-eighths to three-quarters of an inch in diameter, a wick tube surrounding said wick, and a flame guard positioned on the top base of the torch body having laterally-disposed ports for the exit of flame, and smaller laterally-disposed ports below the flame ports for the inlet of air for combustion. Its principal use is as a highway warning signal.

For a clear understanding of the issues involved, the claims must be divided into two classes; 2 and 5 cover the combination of a burner and a torch body, and 11 and 12 are directed to the burner alone.

Of the first group, claim 2 is typical and specifies:

- (a) a torch body having an opening for a wick, and
- (b) a flame guard for said wick, mounted on the outside of said torch body, said guard including
  - (1) a cap provided with an imperforate top wall
  - (2) lateral flame openings adapted to emit luminescent flame, and
  - (3) air ports.

Claim 11, which is typical of the second class, covers:

A burner \* \* \* comprising

- (a) A wick holder having
  - (1) a portion in contact with the wick and
  - (2) a supporting and heat-receiving flange, and
- (b) means enclosing a space above said flange and surrounding the wick, except for provision for
  - (1) lateral exit of flame and
  - (2) restricted entrance of air for combustion.

#### **b. The Conflicting Decisions on the Validity of the Patent.**

Respondent first started infringement proceedings in the District Court at Toledo against Standard Parts, Inc., and Huebner Supply Company, distributors of what will be referred to for convenience as the Bolser and Kari-Keen flares, respectively, the references being to the names of the manufacturers. The patent was held valid and infringed in an unreported opinion by the late Judge Hahn, filed in June, 1935. This decision was reversed by the Sixth Circuit in an opinion by Judge Simons, without dissent, reported in 93 F (2nd) 336.

Of the patent, Judge Simons said in his opinion:

"Stripped of variations in nomenclature, and the ingeniously differentiated phrases of counsel in setting

forth the claims, the invention is for a burner with a metal guard to protect the flame from air currents and rain. The art is full of illustration and description of metal guards for burners. \* \* \* There is sufficient suggestion in a burner guard when it is found in one familiar contrivance to point the way to its use in another \* \* \*

"There is here no substantial evidence of effort general to the industry to solve a problem which long defied it. The proof is limited to experiments of the patentees, and so far as it goes, serves to demonstrate lack of awareness of the teachings of the art rather than the inherent difficulties of the problem itself. They chose the long road to solution, and the patent law does not reward mere persistence, unassociated with original creative effort."

Certiorari was granted on November 21, 1938 to review this decision, in Nos. 166 and 167, October Term, 1938, by reason of the decision in the instant case on November 7, 1938, sustaining the validity of the patent in suit.

A few days before the rendition of the decision in the Sixth Circuit, the bill of complaint was filed against petitioner in the instant case in the United States District Court for the Eastern District of New York. For convenience, the accused device in the instant case will be referred to as the Anthes structure, after Anthes Force Oiler Company, the manufacturer. After a hearing, Judge Moscovitz of that Court filed an opinion, (R. 424-430), finding that the claims in suit were void for want of novelty; that torch bodies and metal guards for the protection of flames were well-known long prior to the filing of the application for the patent in suit; that the claims in suit were aggregative; that the claims in suit involved only me-



chanical skill; that the defendant (petitioner) was using a prior art structure, and that such prior art structure could be used without change for the purposes of the patent in suit.

The Circuit Court of Appeals for the Second Circuit reversed, in an opinion by Judge Manton, Judge Swan concurring, and Judge Chase dissenting without opinion, reported in 99 F (2nd) 806.

In its opinion, the Circuit Court gave the following reasons for differentiating its decision from that of the Sixth Circuit:

"This record, however, contains evidence absent in the Standard Parts case, showing that the art was in search for this accomplishment: that others worked unsuccessfully to solve the problem. \* \* \* The proof here, not found in the Standard Parts case, showed widely-separate, unsuccessful attempts to provide some means which would prevent the flame from being extinguished. Unsuccessful efforts were made over a long period by men skilled in the art of burners. (R. 449.) \* \* \* Unsuccessful attempts have been made by competitors who had long been in the business of manufacturing and selling open flame torches" (R. 450).

The Court held:

"The prior art does not disclose or suggest the combination of result here obtained (R. 451). \* \* \* the device here used as a warning signal—the burner—must be considered as an entirety, that is, the oil container, the wick, the wick tube and the top. \* \* \* While torch bodies and flame guards were old, they have never been used together to perform the function or produce the results of the device of the patent in suit. If they were ever combined for any purpose, it



was not to protect the flame at its source so as to provide a small, protected chamber in which some part of the flame would continue to burn regardless of outside weather conditions, with the greater and visible part of the flame burning as a warning signal outside the guard. This combination and use amounted to invention" (R. 453).

### c. The Prior Art.

All of the patents relied on by the Circuit Court of Appeals for the Sixth Circuit were in evidence in the instant case, but were not specifically relied on by petitioner. These patents are the following:

Hathaway .....	No.	147,496	R. 339
Almond .....	No.	193,796	R. 351
Heston .....	No.	270,587	R. 347
Blake .....	No.	453,335	R. 355
Kahn .....	No.	1,175,527	R. 383

The only patent cited by the Patent Office in prosecution of the patent in suit was Hathaway, No. 147,496, upon which claim 2, as originally drafted, was rejected. (See Record in Nos. 166, 167, p. 99). None of the patents referred to by petitioner were before the Patent Office.

Petitioner below relied upon Russian patent to Malcov, No. 1163 of the year 1868 (R. 325) as an anticipation of claims 2 and 5; on the burner structure of Rutz patent No. 1,101,146 (R. 377) as an anticipation of claims 11 and 12. In addition to the Rutz patent, petitioner relied on widespread public use of the Rutz structure as an anticipation of claims 11 and 12. Wall, No. 228, 497 (R. 343) was referred to as a state-of-the-art patent showing the combination of a torch body and a flame guard as early as 1880.

The Malcov patent is for a chimneyless lamp burner and shows the combination of a torch body, a wick, and

wick tube, and a metal guard enclosing the end of the wick. The patent drawing shows the structure with flames emanating from the sides of the guard. The top of the guard is perforated with tiny holes. Petitioner's expert, Dr. Matthew Luckiesh<sup>1</sup>, Director of Lighting Research for the General Electric Company, however, testified that the Malcov top was "imperforate," in the sense that it offered protection from rain, because the surface tension of the rain drops prevented their going through the tiny holes in the top (R. 80, ff. 238-239; R. 100, f. 299).

The Rutz patent covers a flash igniter for a stove, and the portion of it relied on is the cylindrical hood 8 (Fig. 1 of drawings, R. 378) having air inlet ports 7 horizontally disposed in the bottom flange of the hood and flame openings 8 laterally disposed in the side walls thereof.

A device designed in accordance with the Rutz patent went into commercial use and was widely sold by the Milwaukee Gas Specialty Company of Milwaukee, Wisconsin. The record shows that A. O. Rutz, inventor of the Rutz patent No. 1,101,146, designed the hood 8 to protect the flame of the igniter from precipitated liquids, and lateral currents of air, and that it was tested from time to time to determine its resistance to such elements (R. 393, f. 1177).

Of Rutz, petitioner's expert, Dr. Luckiesh, testified that if the hood 8 were transferred to a torch body, "All the principles of operation remain the same." (R. 127, f. 379, RDQ 339).

As a result of the so-called flare laws, the majority of the states have established administrative qualifications for the use of torches on the highways, and some of the states have designated laboratories for the purpose of

<sup>1</sup>For Dr. Luckiesh's record, see "Who's Who in America," Vol. 20 (1938-1939) p. 1576; he has had 27 years experience during which time he has "done a lot of work on kerosene burners" (R. 122, XQ 333).

testing flares submitted for the approval of state highway commissions.

It is claimed by respondent that no prior art torch will pass the tests which have been promulgated. Petitioner procured three flash igniter guards embodying the hood of the Rutz patent, from the Milwaukee Gas Specialty Company, mounted them suitably on commercial torch bodies, and submitted them to the Nebraska Department of Roads and Irrigation for qualification. They were promptly qualified (R. 413-423). Photographs of the structures submitted are shown on pages 414 and 416 of the record and are reproduced as Figures 1 and 2 on pages 9 and 11 hereof. Respondent's witness on the point agreed that Nebraska was one of the most difficult states in which to obtain a qualification (R. 52, f. 156).

#### **d. History of the Torch Industry.**

Open flame torches, comprising a fuel reservoir, wick tube and wick, have been used for numerous purposes, perhaps beyond the memory of man. The first use as warning signals disclosed by the record is that of the Detroit Street Railway, which began using a cast iron, three-wick pot torch about 1913. It ordered its torches as it required them from foundries, accepting the lowest bid for the work. From this, it is a rational inference that at that time there was no organized manufacture of the articles.

So far as the present record discloses, the first person to manufacture a stamped, sheet-steel-pot torch for general distribution was one McCloskey, of Toledo, Ohio, who engaged in this activity perhaps as early as 1925. To protect his structure from turning over, he weighted the bottom, for which advance in the art he was awarded patent No. 1,610,301. In 1926, respondent was manufacturing the torches for McCloskey, under contract, and in the latter

part of that year, respondent apparently decided to engage in the enterprise on its own behalf, at which time it brought out its first torch, weighted at the bottom and similar to McCloskey's torch. McCloskey brought suit against respondent for infringement, and his patent was held invalid for anticipation by the Circuit Court of Appeals for the Sixth Circuit in *McCloskey v. The Toledo Pressed Steel Co.*, 30 F (2nd) 12.

Respondent advertised the virtues of its open flame torch as:

"The Toledo torch will burn all night, anywhere, at any time, in any kind of weather. It is an all-purpose danger signal" (R. 263)<sup>2</sup>.

It is nevertheless said that respondent received many complaints that its torch would be extinguished under severe weather conditions, and patentees, in 1928, commenced a series of experiments to improve the device.

Their first experiments consisted in making the top of the wick tube flush with the top base of the torch body, and projecting the wick tube into the interior of the fuel reservoir, an example of the structure being shown in the circular reproduced on page 289 of the record. The theory of this structure was that the wick would conduct heat inside of the torch body, raising the temperature of the fuel and reducing the tendency to blow out. The device was brought out in July, 1928, and sold during the balance of that year.

Patentee, Withrow, testified that the improvement did not answer all the problems, and further experiments were made, drawings thereof being reproduced on pages 271 to 287 of the record. The experimenters first placed a series of plates around the sides of the wick, then (R. 275) completely housed the flame with a dome-shaped cap having

<sup>2</sup> A reproduction of this circular is shown in Fig. 4 on page 41 hereof.



ports in both the top and sides. Various types of caps were tried, all having imperforate tops and side flame ports, the final result being shown on record page 287. The application for patent was filed December 26, 1928, and the torches were first offered for sale in January of 1929. The structure with the cap was so designed that caps could be sold separately to previous purchasers of respondent's open flame torch, and be readily attached to such torch (R. 25, f. 74).

From 1929 to 1933, torches of the type here involved were used solely as warning signals, about construction work. In the late spring of 1933, the State of Iowa first passed a statute requiring trucks using the highways to carry three torches as warning signals, and requiring the drivers to light and place the torches about the truck whenever the truck stopped on the highways at night. In June of 1933, Anthes Force Oiler Company of Fort Madison, Iowa, whose torch is the accused device in the instant suit, began to manufacture a torch of the type shown on page 253 of the record as licensees of respondent. In July of 1934, because this type of torch with the burner positioned directly on the torch body, was too hot for the operator to handle in practical operation (R. 133, f. 397), the Anthes Company changed to the present style, shown on page 297 of the record, in which the flame guard is elevated on the wick tube and the air inlet ports are positioned in a horizontal flange, below the flame. This obviated the objection (R. 133, f. 398).

Prior to 1933, torches as such were sold only to the contracting industry engaged in street repair and road building, where warning signals were necessary for unprotected excavations. After the passage of the Iowa statute, the devices used on trucks began to be known as "flares." Shortly after Iowa first passed a so-called flare law, a substantial proportion of the other states passed similar laws requiring trucks using the highways to carry flares of the



type here involved, which resulted in a very substantial demand for flares.

A tabulation of respondent's sales of torches or flares from the beginning through the year 1937 follows:

Year	Units Sold	Type Sold
1926	1,121	Ex. 10
1927	26,630	Ex. 10
1928	39,000 (est.) *	Ex. 10, 13
1929	46,624	Ex. 17
1930	53,422	Ex. 17
1931	52,953	Ex. 17
1932	43,197	Ex. 17
1933	76,919	Ex. 17
1934	56,401	Ex. 17, 19
1935	134,831	Ex. 17, 19
1936	186,479	Ex. 17, 19
1937	129,739	Ex. 17, 19

\* The last 5½ months for sales of Exhibit 13 must be estimated: plaintiff gave only the figure of 19,689 of Exhibit 10 down to July 15, 1928, but there is no reason to suppose there was any loss of sales when Exhibit 13 was brought out.

#### **a. The New Evidence Presented for the First Time in the Instant Case.**

As we pointed out in section "b," *supra*, the Court below found evidence in the record of unsuccessful attempts by "competitors who have long been in the business of manufacturing and selling open flame torches" to solve the problem said to have been solved by the patent in suit.

The attempts so characterized consisted of two instances only, one effort during the period from 1922 to 1924 by a Superintendent of Way and Structures of the Detroit Street Railways, who was not a torch manufacturer nor a man skilled in the art of burners. He made only one attempt to solve the problem, and that by placing a flat shield over the top of a pot torch having three wicks. The experiment was abandoned, according to the witness who tes-

tified, because the pins supporting the flat top

"Would be bent and sometimes broken \* \* \* and we still had trouble with torches being extinguished in a drenching rain or a very high wind, and so we concluded that those happenings were so infrequent that we could just as well get along without the cap, and we discontinued the use." (R. 59, f. 176.)

This concern still uses the open flame torch (R. 61, f. 181).

○ The other attempt was that of Currie, the Works Manager of the R. E. Dietz Company, a concern which for many years was a large manufacturer of lanterns. In 1928, when the experiments were made, the Dietz Company was not a competitor of respondent, and had never been engaged in manufacturing and selling open flame torches. The Dietz Company found that its lantern business was suffering from the new torch industry (R. 168, f. 502), which, as we pointed out *supra*, apparently originated with one McCloskey, in Toledo in 1925 or 1926.

In 1928, about a year after the Toledo torch first came on the market, Currie, the Works Manager of the Dietz Company, began to experiment with it, to see whether the claims for infallibility, quoted *supra*, were well founded and discovered that it would not stand up in "a very heavy rain. There was nothing to protect it at all." (R. 168, f. 504.) During his experiments, Currie produced three devices, one of them being Exhibit 37, which "would operate with a much lower wick and withstand a very high wind." (R. 171, f. 511.) Currie further testified:

"I tried it out in the rain and it went out. It occurred to me that I might possibly put a flat shield over the top so that the rain would not get in the center of the wick, that is, that thought must have been in my mind, but I just didn't do it." (R. 175, f. 523.)

Currie claimed to have designed more than the three structures which he produced in Court, but the absence of the others was not accounted for.

No other evidence of widely-separate, unsuccessful attempts than that here referred to was offered. No evidence of "unsuccessful attempts" . . . by competitors who have long been in the business of manufacturing and selling open flame torches" (referred to in the opinion of the Court below, [R. 450]) can be found in the record.

#### **f. Performance of the Structures.**

The recitals of the specification of the patent in suit state as an object: "A simple and efficient attachment . . . for increasing the efficiency" of such torches (p. 1, ll. 8-10). It is further stated (ll. 93-98):

"It has been found that with the above described construction and arrangement, the oil consumption is materially decreased. It is also found that the amount of wick used is likewise decreased."

Respondent seeks to substantiate its claims by evidence of some comparative tests conducted by the patentees out-of-doors, conditions being uncontrolled, between one of its early torches and a torch containing the patent flame guard. Samples of the types which respondent tested are shown in the photograph on page 261 of the record, torch B being tested against torch C. The result of these tests was that the patented torch used 2.06 ounces of oil per hour as against 4.95 ounces for the open flame torch.

Of tests of this type, petitioner's expert, Dr. Luckiesh, testified (R: 83, f. 247):

"The only way you can arrive at a fundamental is control of all variables except one. The only way you can get basic, foundational information on the effect of a cap on efficiency is to test it on and off of a given device. That is the research approach. There is no other way."

He was further of the opinion that a comparison of torch B against torch C was not a fair test of efficiency (R. 95, f. 283).

Petitioner ran a series of tests in the Engineering Laboratories of the University of Iowa under controlled conditions, supervised by Professor Huber O. Croft, head of the Department of Mechanical Engineering in that institution. The results of these tests are as follows:

<i>Air Velocity m.p.h.</i>	<i>Fuel Consumption in lbs. per hour</i>	
	<i>With Flame Guard</i>	<i>Without Flame Guard</i>
0.0	.037	.094
1.75	.172	.135
4.75	.255	.193
8.5	.340	.239
14.0	.303	.429
25.5	.408	.....

As to wick consumption, Professor Croft testified:

"It was impossible to detect any consumption in the wick by measurement with a rule. \* \* \* The nearest 1/120 of an inch could be estimated. \* \* \* " (R. 150, f. 450.)

The test for wick consumption covered a six-hour burning period.

As to the proposition that the addition of the flame guard increased the efficiency of the structure, Professor Croft tested devices with and without a flame guard, under still air conditions and velocities of 1.75, 4.5, 8.5, 14 and 25 miles per hour, each test being run for an hour, taking observations of both fuel consumption and illumination. Using the term "efficiency" as it is defined in the lighting art, light output per unit of energy input (R. 75, f. 223). Professor Croft determined that under all circumstances where the open flame torch would burn, it was more efficient than the patented torch, a graphic portrayal of this being shown in Fig. 35 on page 399 of the record, reproduced on page 19 hereof, as Fig. 3. Respondent offered no evidence to substantiate its claims to efficiency.



*Fe...*

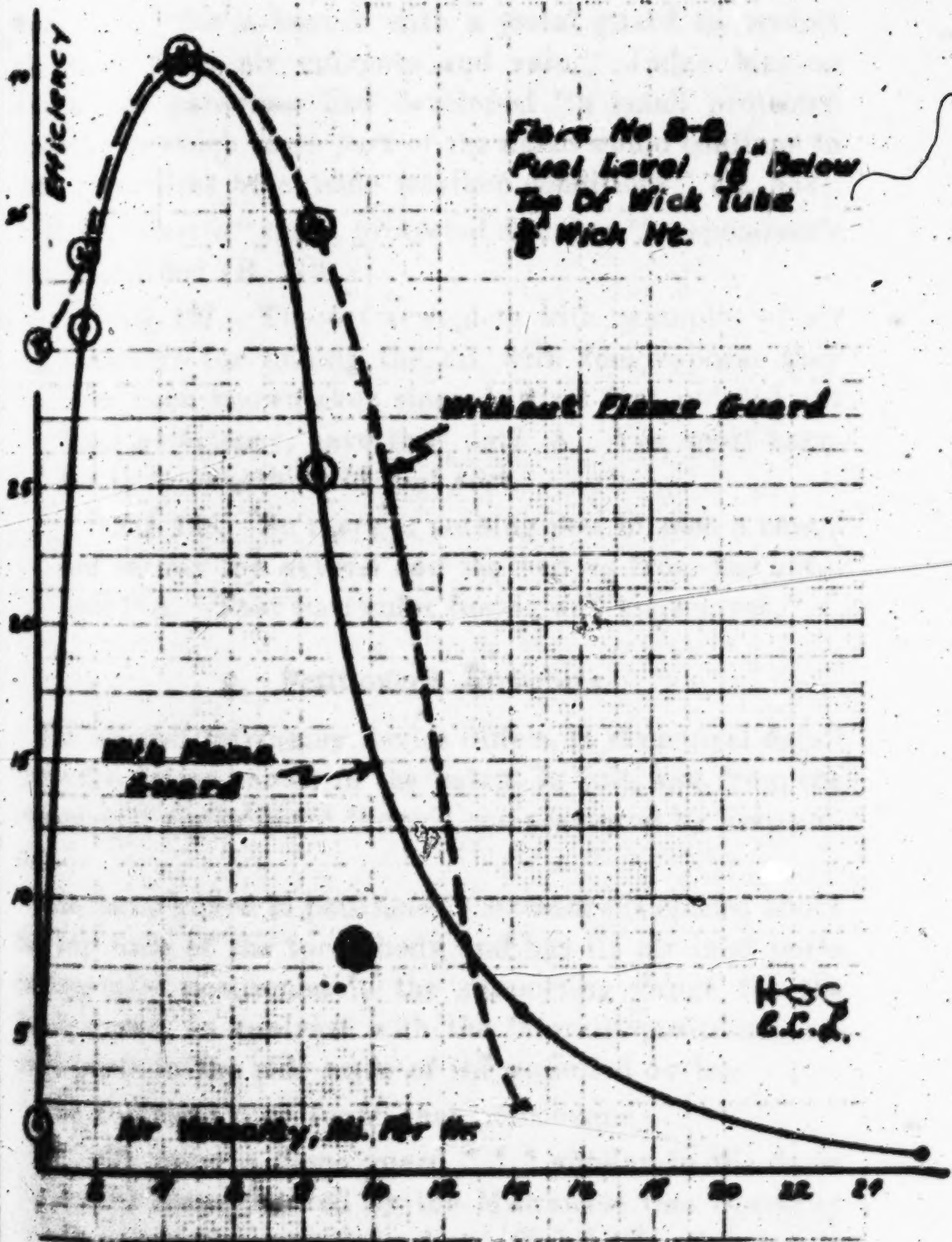


Fig. 2.5



While Judge Simons, speaking for the Sixth Circuit, found that the invention of the patent in suit is nothing more than "for a burner with a metal guard to protect the flame from air currents and rain," Judge Manton found that patentees had developed "a small protected chamber in which some part of the flame would continue to burn regardless of outside weather conditions" (R. 453).

Of the Court's "small, protected chamber," respondent's expert testified (R. 219):

"XQ 127. The art is replete with examples of air chambers for mixing the air with fuel vapors: they have been known ever since Argand first pointed out their pertinency, have they not? A. Yes, most burners have something of that sort.

"XQ 128. So there is nothing new in such a chamber to mix the oxygen and the vapors from the kerosene? A. That particular fact is well known, yes."

#### **g. Petitioner's Structure**

The alleged infringing device differs in structural detail from the device shown in the patent in suit, and from the commercial embodiment thereof manufactured by respondent.

The flame guard in petitioner's structure is spaced above the top base of the torch body and has its air inlet ports horizontally positioned in the supporting flange for the flame guard, in contrast with the laterally-positioned air inlet ports in the side walls of the patented device.

The District Court found that petitioner:

"Is using a flame guard \* \* \* similar to the flame guard manufactured by the Milwaukee Gas Specialty Company shown in defendant's Exhibit L, except as to the size of the flame ports, and the Court finds that the

difference in size between the flame ports of (petitioner's) structure and of the Rutz flame guard is immaterial." (R. 430, f. 1288.)

Professor Croft's tests of petitioner's and respondent's devices showed that the two operated differently, the performance curves of petitioner's structure being shown in Fig. 11 (R. 395) and of the respondent's in Fig. 33 (R. 399).

After the Croft tests were completed, respondent made some comparative tests of the two structures under conditions different from those used by Professor Croft. One of the patentees, who made the tests, stated:

"The performance results which I obtained between the Anthes and the Toledo were opposite to each other but of similar quality, in the opposite direction." (R. 191, f. 572.)

This was corroborated by the other patentee, who stated that the performance of the two torches was "quite the opposite." (R. 183, f. 548.)

Professor Croft testified that in his opinion the reasons for the difference in performance could be accounted for by the differences in construction:

"That is, in the Toledo flare, the wick and flame guard are adjacent to the top of the body of the flare and the air ports are in the sides of the flame guard while in the Anthes flare the wick and receptacle are elevated above the body of the top of the flare and the air ports are at the bottom of the flame guard receptacle." (R. 155, f. 464.)

One of the elements of the patent structure, pointed out in lines 78 to 89 on page 1 of the specification, is as follows:

"Air inlet openings 10 being above the lower edge of the cap leaves a space within the cap and above the

flange of the wick holder for comparatively quiescent air. This quiescent layer of air in contact with the wick holder and the restriction of the inlet ports to admit to the wick and holder only such air as is needed for combustion aids in maintaining the heat of the wick holder and wick. This militates against extinguishing the flame by high winds."

Of petitioner's device, its expert testified that under any conditions of its operation, the feature of a layer of quiescent air could not exist. (R. 91, f. 271.)

#### IV.

#### SPECIFICATION OF ERRORS.

1. The Court below erred in holding that the device of the patent in suit must be considered as an entirety, or that it was "a unitary structure, patented as an entirety."

2. The Court below erred in not finding that claims 2 and 5 of the patent in suit were aggregative, and in not applying thereto the doctrine of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545.

3. The Court below erred in not finding that claims 2 and 5 of the patent in suit were anticipated by Russian patent to Malcov, No. 1163 of the year 1868.

4. The Court below erred in not finding claims 11 and 12 were anticipated by patent to Rutz No. 1,101,146.

5. The Court below erred in finding that the prior art does not suggest the combination of the patent in suit.

6. The Court below erred in finding as a fact:

"That others worked unsuccessfully to solve the problem. . . . Unsuccessful efforts were made over a long period by men skilled in the art of burners. . . ."

Unsuccessful attempts had been made by competitors who had long been in the business of manufacturing and selling open flame torches. \* \* \*

7. The Court below erred in finding as a matter of law that the history of the art demonstrated that the accomplishment of the patent in suit was not easy or apparent, nor merely the work of one skilled in the art.

8. The Court below erred in not finding that nothing more than mechanical skill was involved in the association of a flame guard with a torch body.

9. The Court below erred in finding that the dome shaped cap of the patent in suit was more than a flame guard.

10. The Court below erred in not finding that the claims in suit were void as being for a double or analogous use, for the hood of the Rutz patent No. 1,101,146, or that the claims were invalid because the Rutz hood could be used without change for the purposes of the patent in suit.

11. The Court below erred when, after finding that the hood of the Rutz structure did not anticipate the claims of the patent in suit, in holding that the defendant infringed; since the defendant was found to be using the Rutz structure, the Court should have applied the maxim: "That which does not anticipate cannot infringe."

12. The Court below erred in departing from the theory of operation expressed in the patent specification, wherein the patentees had limited themselves to the type of structure in which lateral air inlet ports are positioned in the side walls of the flame guard so that a layer of comparatively quiescent air may be maintained, disclosed in the specification and drawings, to find infringement on the part of the petitioner.



## V.

**SUMMARY OF ARGUMENT.**

## I.

**Claims 2 and 5 are aggregative.**

*Lincoln Engineering Co. v. Stewart-Warner Corp.*,  
303 U. S. 545, 549-550;

*McGrath Holding Corp. v. Anzell*, 2nd Circuit 58  
F (2nd) 205;

*In re Ratican*, 1911 C. D. 267, 36 App. D. C. 95;

*Westinghouse Electric & Mfg. Co. v. Wagner etc.*  
*Co.*, 235 U. S. 604, 614;

*Stromberg Motor Devices Co. v. Zenith Detroit*  
*Corp.*, 2nd Circuit, 73 F (2nd) 62;

*Elizabeth v. American Nicholson Pavement Co.*,  
97 U. S. 127;

*In re Germantown Trust Co.*, 57 F. (2nd) 365;

*Carbice Corp. v. American Patents Development*  
*Corp.*, 283 U. S. 420, 421.

## II.

**The claims in suit are void for anticipation.**

- a. Claims 2 and 5 are anticipated by Malcov Russian patent No. 1163 of the year 1868.
- b. Claims 11 and 12 are anticipated by Rutz patent No. 1,101,146.

*M. & B. Mfg. Co. v. Munk*, 2nd Circuit, 77 F. (2nd)  
261, 262.



## III.

Nothing more than mechanical skill was involved in association of a flame guard, similar to the Rutz hood, with a torch body.

*Carlton v. Bokee*, 17 Wall. 463;

*N. Y. Scaffolding Co. v. Chain Belt Co.*, 254 U. S. 32, 36-37;

*Thompson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 447;

*Keyes v. Grant*, 118 U. S. 25, 36;

*Dunbar v. Meyers*, 94 U. S. 187;

*De Forest Radio Corp. v. General Electric Co.*, 283 U. S. 664;

*Paramount-Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474;

*Concrete Appliances Co. v. Gomery*, 269 U. S. 175, 185;

*Powers-Kennedy etc. Corp. v. Concrete Mixing etc. Corp.*, 282 U. S. 175, 186;

*Carbice Corp. v. American Patents Development Corp.*, 283 U. S. 420, 421;

*Altoona-Publix Theatres Corp. v. American Tri-Ergon Corp.*, 294 U. S. 477, 486;

*Vandenburg v. Truscon Steel Co.*, 261 U. S. 6, 15.

*Textile Machine Works, Inc. v. Louis Hirsch Textile Machines, Inc.*, 2nd Circuit, 87 F (2nd) 702, 705, aff'd. 302 U. S. 490.

## IV.

The patent in suit is for a double or analogous use of the Rutz hood, and is void under the patent statute, since the Rutz hood can be employed without change for the purposes of the patent in suit.

*Aron v. Manhattan Rwg. Co.*, 132 U. S. 84;

*Mast, Poos & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 493;

*Miller v. Force*, 116 U. S. 22, 28;

*Grant v. Walter*, 148 U. S. 547, 556;

*Knapp v. Morss*, 150 U. S. 221, 227-228;

*Dicight & Lloyd Sintering Co. v. Greenawalt*, 2nd Circuit, 27 F (2nd) 823;

*Ingersoll Rand Co. v. Worthington etc. Co.*, 2nd Circuit, 87 F (2nd) 320;

*Potts v. Creager*, 155 U. S. 597;

*Nat'l Cash Register Co. v. Boston Cash Indicator Co.*, 156 U. S. 502;

*Hobbs v. Beach*, 180 U. S. 383, 392-393;

*Rockwood v. General Fire Extinguisher Co.*, 2nd Circuit, 8 F (2nd) 682, 686.

## V.

If it be the holding of the Court that the Rutz hood does not anticipate claims 11 and 12, then petitioner's device does not infringe, since it is using the Rutz hood in its device.

*Peters v. Active Mfg. Co.*, 129 U. S. 530, 537;

*Grant v. Walter*, 148 U. S. 547, 553, 556;

*Knapp v. Morss*, 150 U. S. 221, 226;

*American Fruit Growers Inc. v. Brodex Co.*, 283 U. S. 1;

*Rockwood v. General Fire Extinguisher Co.*, 2nd Circuit, 8 F (2nd) 682.

## VI.

Infringement can be found only through a departure from the theory of the specification and by construing the claims to extend beyond the invention; as construed by the Court below the claims are clearly void.

*Scriber-Schroth Co. v. Cleveland Trust Co.*, Nos.

3-5, Oct. term, 1938, decided Nov. 7, 1938;

*Snow v. Lake Shore & M. S. R. Co.*, 121 U. S. 617, 630;

*Mackay Radio etc. Co. v. Radio Corporation*, No.

127, October term, 1938, decided January 30, 1939;

*St. Pierre v. Redpatch etc. Co.*, 2nd Circuit, 87 F (2nd) 766.

**ARGUMENT.****I.**

**Claims 2 and 5 are aggregative.**

The Court below stated as one of its premises:

"While torch bodies and flame guards were old, they have never been used together to perform the function or produce the results of the device of the patent in suit."

The statement that both types of device are old is abundantly apparent from the record, a perfect example being found in Wall, No. 228,497 (R. 344). Wall's patent was for a chimneyless "mill-lamp" or "torch-lamp," consisting of a torch body A, a wick tube E containing a tubular wick, and a burner G having imperforate sloping sides and a slit in the top through which the flame played. We have not offered Wall as anticipating, since the phraseology of all of the claims in suit suggests an "imperforate dome-shaped cap," and Wall has his flame opening in the top of his cap, and his form is pyramidal rather than dome-shaped. Otherwise, the Wall device is completely comparable to that of the patent in suit. Wall in itself is sufficient to negative the second half of the Court's premise:

"They have never been used together to perform the function or produce the results of the patent in suit."

Unfortunately for the clarity of the issues, the Court below ignored the Wall patent.



It is further to be noted that when the device of the patent in suit was designed, it was arranged so that the dome-shaped cap or flame guard could be added to the old open flame torch previously manufactured by respondent. No change was made in the torch body, wick tube or wick.

Claim 2 purports to cover the combination of:

- (a) a torch body and
- (b) a flame guard, including
  - (1) a cap with an imperforate top wall,
  - (2) lateral flame openings adapted to emit luminescent flame, and
  - (3) air ports.

Claim 5 is sufficiently like claim 2 so that it needs no separate analysis.

Other examples of combination of torch bodies, wick and flame guards shown in the record are Russian patent to von der Weide, No. 1261 of 1869 (R. 335) in which we find a torch body A and a flame guard C, and Russian patent to Malcov, No. 1163 of 1868 (R. 325), in which we find the combination of a torch body, unnumbered, and a flame guard d-d.

These examples clearly demonstrate that the particular combination set forth in claims 2 and 5 was very old in the art. Let us suppose, for the sake of argument, that the type of flame guard disclosed in the patent in suit was novel. Claims 2 and 5 would nevertheless be void under the doctrine of *Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U. S. 545, in which case Mr. Justice Roberts said, at pages 549-550:

"As we said of Gullborg in the Rogers case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other

old elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. *And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.*" (Italics ours.)

As phrased in claims 2 and 5, the alleged invention clearly sought to cover the improvement of one part of an old combination. Such a claim is clearly void, since the unimproved parts of the alleged combination obviously perform no new function in the combination. The device was so designed, indeed, that the supposedly novel flame guard could be added to prior structures, which remained otherwise unchanged (R. 25, f. 74).

A case in the Court below deciding the same point was *McGrath Holding Corp. v. Anzell*, 58 F (2nd) 205, where it was said, per Judge Manton:

"Since this combination was old, the inventor of a new form of one element cannot claim the entire combination, even though he includes his new form of element. . . . The combination of the old elements with the new clamp was new, we think, but this did not amount to invention."

The Court below has sought to differentiate the principles announced in these cases without, however, referring to them, or attempting to distinguish them, upon the theory

that the patent in suit covers a "unitary structure, patented as an entirety." It is stated:

"But the device here used as a warning signal—the burner—must be considered as an entirety, that is, the oil container, the wick, the wick tube and the top."  
(R. 452-453.)

Such an argument overlooks the obvious proposition that there can be no functional relationship, as such, between a fuel or other reservoir and the means used to utilize the fuel. This point is clearly brought out in *In re Ratican*, 1911, C. D. 267; 36 App. D. C. 95, a leading and much-cited case, in which the validity of a claim on the combination of:

"A wheel truck having a water tank thereon and supply and delivery pipes for said tank, and a sector-shaped delivery nozzle \* \* \*,"

was held unpatentable both by the Patent Commissioner and the Court of Appeals for the District of Columbia. It was assumed for the purposes of the decision that the form of nozzle was novel, but there could be no invention in combining it with a water tank. *In re Ratican* was cited with approval by Mr. Justice Roberts in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 550, footnote 6.

Another leading case cited in footnote 6 of the *Lincoln Engineering Case* referred to is *In re Germantown Trust Co.* (Ct. Customs & Patents Appeals) 57 F (2nd) 365, involving combination claims on improvements in fuel gauges for motor vehicles. Two of the elements involved were con-



ceded to be novel, yet the claims were held to be unpatentable for reasons given in the *Lincoln Engineering Case*.

Similarly, there can be no patentable combination between the carburetor and the gas tank, or between a burner and a reservoir for kerosene. The patentable novelty, if any, must reside in the burner itself, and not in its combination with a source of fuel supply.

As authority to justify the aggregation of the flame guard and the fuel reservoir on the theory that it was "a unitary structure patented as an entirety," three cases involving the question of damages are cited. The facts of these cases cannot possibly be applied to the facts of the instant case.

Reference to a "unitary structure" is old to the patent law where the Court is called upon to apportion profits when a defendant is entitled to manufacture a part of the alleged infringing structure, or where a defendant has added something of his own. Thus the Court said *obiter* in *Westinghouse etc. Co. v. Wagner etc. Co.*, 225 U. S. 604, 614, per Mr. Justice Lamar:

"Where profits are made by the use of an article patented as an entirety, the infringer is liable for all the profits 'unless he can show—and the burden is on him to show—that a portion of them is the result of some other thing used by him.' "

But in that case, the Court did not even hold that the Westinghouse transformer was "patented as an entirety," but remanded it for a new hearing to determine whether an apportionment of profits was necessary or not.

The Second Circuit case referred to, *Stromberg Motor Devices v. Zenith Detroit Corp.*, 73 F (2nd) 62, was likewise an accounting case under the Mock patent on a car-



buretor, which was held to be a unitary structure, the plaintiff being entitled to all the profits. This is easily understandable since it seems to have been agreed by the experts on both sides that the patent was "more than a mere aggregation by combining two old devices." One judge, however, dissented on the ground that even the carburetor was not unitary and that profits should be apportioned. This case might be informative if the Mock patent had covered the gas tank as well as the carburetor, but on the facts, it does not help.

*Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 127, the third authority referred to by the Court below, is somewhat different, involving the question of the validity of a combination patent for street paving, and questions of profits. The patent covered a pavement comprising a foundation, parallel-sided wood blocks, strips between the blocks to space them and a filling of gravel and tar. None of the alleged anticipations combined all the elements, much less an arrangement of the elements according to the patent. On the question of profits, the Court characterized the patented pavement as: "A new thing, like a new chemical compound."

This is hardly the category in which respondent's pot torch and flame guard can be placed. Not only are the elements old, but the combination of a torch body and flame guard is old, and only in the precise type of flame guard, with the air ports in the side walls of the guard, can we find a dubious newness, if it can be found anywhere.

It is thus apparent that the Court below has forcibly lifted a principle from the law of accounting, where its function is to determine the burden of proof, and injected it into the law of aggregations where it has no proper place, burden of proof not being a consideration. The creation of

new rules of law through analogy is sometimes necessary, but analogies can be forced only so far before the breaking point is reached, as it is here when one considers that under the rule of *Westinghouse etc. Co. v. Wagner etc. Co.*, 225 U. S. 604, 614, quoted, even though an article be "patented as an entirety," the infringer has the privilege of showing that some portion of the profits derived from the sale are attributable to his additions to the device.

The most recent case presenting what might be classified as a unitary structure as respondent sees it, is *Carbice Corp. v. American Patents Development Corp.*, 283 U. S. 420, 421, in which a refrigerating container was considered. Of it, the Court said, per Mr. Justice Brandeis, at page 421:

"The alleged invention is for the locational arrangement of materials within a container. Whether a locational arrangement within a structure can ever be patented as a manufacture need not be determined.

\* \* \* For the combination in suit lacks patentable invention and novelty. Each of the elements—refrigerant, material to be refrigerated, and container—perform its function in a known way."

All of these considerations apply completely to the instant case, as will be pointed out more specifically under Sections III and IV *infra*.

## II.

**The claims in suit are void for anticipation.**

- a. Claims 2 and 5 are anticipated by Malcov Russian patent No. 1163 of the year 1868.

All of the elements specified in claims 2 and 5 are found in the early Russian patent to Malcov, No. 1163 of the year 1868 (R. 325).

Claim 2 covers the combination of:

"In a device of the class described" (Malcov is of that class)

"(a) a torch body" (Malcov has a torch body) "having an opening for a wick" (Malcov has an opening for a wick) "and

(b) a flame guard for said wick mounted on the outside of said torch body" (Malcov has a flame guard mounted on the wick tube, but respondent's contention is that such a mounting is within the scope of this claim) "said guard including

(1) a cap provided with an imperforate top wall, and

(2) lateral flame openings adapted to emit a luminescent flame" (Malcov has such flame openings and shows them emitting luminescent flame)

"and

(3) air ports."

Respondent attempts to differentiate Malcov because he has no air ports and because he provided minute perforations in his top.

The minute perforations may possibly have been inserted as orifices through which gas, which burns outside as flame, might be emitted. The evidence shows, however, that Malcov's top is imperforate in the sense that rain does not penetrate to the interior, by reason of the surface tension of the rain drops (R. 80, f. 238-239; R. 100, f. 299).

The other point of differentiation is that Malcov has only one opening for the inlet of air and the emission of flame. In this aspect, Malcov, to all practical purposes, is no wise different from the structure of the patent in suit. Dr.

Luckiesh pointed out, in reference to the operation of the structure of the patent in suit, that the air ports did not supply sufficient air at zero wind, which was the reason for the extremely low candle power provided by the device under such a condition. At any winds above zero velocity, the air ports were not needed, because the flame ports became air ports automatically (R. 88, f. 262). Respondent's expert agreed that in any appreciable wind, more air would be coming in through the flame openings than through the air openings (R. 219, f. 657, XQ-132).

Respondent's principal criticism of Malcov, however, has been directed to the deficiencies of his patent draftsman, and not to the inapplicability or inoperability of his device. Contrary to the supposition of the Court below, Dr. Luckiesh had no difficulty in understanding the operation of Malcov (R. 103, XQ 210, ff. 308-309). It presents all of the elements of an anticipation, in that it has all the items described in the claims which it is alleged to anticipate, and can operate satisfactorily for the purposes of the patent in suit (R. 81-82, ff. 243-244). Malcov was not considered in the Patent Office prosecution (see Record in Nos. 166, 167, page 99).

b. Claims 11 and 12 are anticipated by Rutz patent No. 1,101,146.

Claim 11 covers: "A burner for a construction torch adapted to emit luminescent flame, \* \* \*."

All of the language after the word "burner" is functional, and is directed to the purposes to which the burner is to be put. It can furnish no basis for giving the claim a validity to which otherwise it would not be entitled.

Disregarding this functional language, claim 11 covers:

(a) a wick holder having

(1) a portion in contact with the wick and



(2) a supporting and heat-receiving flange, and

(b) means enclosing a space above said flange and surrounding the wick except for provision for lateral exit of flame and restricted entrance of air for combustion.

While the Rutz hood 8, shown in Patent No. 1,101,146, is not a "burner for a construction torch," it is nevertheless a flame guard adapted to emit luminescent flame, since, as we shall point out at greater length, *infra*, it may be used without any change whatsoever to achieve the results sought to be attained in the patent in suit.

The Rutz hood 8 is a burner; it has a flange which respondent characterizes as a "supporting and heat-receiving flange," when used by petitioner in its structure; it has a "means enclosing a space above said flange and surrounding the wick except for provision for lateral exit of flame," 8' in the patent drawings (R. 378); and it has "restricted entrance of air for combustion," 7 in the patent drawings.

Claim 12 covers substantially the same elements as claim 11 and is similarly anticipated by the Rutz hood.

All of the requirements for an anticipation are present when the anticipating device may be used without change for the purposes of the patent. "It is enough to anticipate if the earlier device is susceptible of the new use, as it stands and without change." *M. & B. Mfg. Co., v. Munk*, 2nd Circuit, 77 F (2nd) 261, at page 262, per Judge L. Hand.

The Rutz hood 8 was likewise not considered in the Patent Office prosecution (see record in Nos. 166, 167, page 99).

## III.

Nothing more than mechanical skill was involved in association of a flame guard, similar to the Rutz hood, with a torch body.

While it would seem clear from the foregoing that the patent in suit can have no validity in view of the prior art, it has nevertheless been argued at length by respondent that the addition of a burner cap or a flame guard, having air inlet ports and flame outlet ports, to a torch body for use as a warning signal upon the highways, was a brilliant flash of genius upon the part of the patentees, entitling them to a status of generic inventors fortified with claims broad in scope.

Patentees claim to have been popularizers of such a device, and pioneers in developing highway warning signals. They say their device is the only one which will successfully satisfy the rigid requirements set up by state testing laboratories.

If there were a torch industry, respondent came into it very late. Patentees were introduced to the industry by McCloskey, the first popularizer of sheet metal open flame torches, and for some time respondent produced such torches for McCloskey as a contract fabricator. Patentees found their principal's business good and decided to engage in it upon their own behalf. What skill in the art they had was acquired as they went along.

Sometime in 1928, it became apparent to them that means would have to be provided to prevent the flame from being extinguished by wind or rain. This consciousness existed while their advertising literature continued to extol the efficacy of the open flame torch, which it was represented to prospective purchasers would "burn all night, anywhere, at any time, in any kind of weather," (R. 263). (See also

Fig. 4, p. 41 hereof). Whatever be the truth of the matter, the continued reiteration of such a claim in the face of the known deficiencies of the device necessarily shakes one's confidence in patentees' good faith. When a manufacturer is once impaled upon the spike of a consciously false claim, it is but a rational inference that claims of the functional superiority of a succeeding device may be equally untrue. The point is important, in view of the present extravagant claims made by the patentees in the specification and on the witness stand.

Patentees first attempted to pre-heat the oil by extending the wick tube into the container, the desirability of which was pointed out to them if nowhere else, in the case of *Carlton v. Bokee*, 17 Wall. 463, where it was stated:

"In (the old lamps) the flame was set close to the lamp, and the wick tube holding the wick was projected downward into the oil, so that the heat of the flame might be communicated thereto in order to render it more fluid and susceptible to the capillary attraction of the wick,"

which was common knowledge when that case was decided in 1872. Patentees' first effort utilized these features, and they have been continued into the patented structure as a basis for invention. It was found not to be enough, whereupon patentees placed a set of baffle plates around the wick (R. 271-273). Salsbury produced a structure superior to these in 1895 (R. 329). Since these left the top open so that rain could snuff the flame, it became apparent that some sort of horizontal top covering was necessary. The first structure of this type is shown on page 277 of the record, and the second, shown on page 279, differs but little from the structure ultimately adopted.

The unfortunate aspect of these experiments lies in the unnecessary motions in which the patentees indulged before

## THE TOLEDO TORCH

The only real protection for open construction work at night.

The minimum protection required by law (red lanterns) is not sufficient to keep you out of personal injury suits. But—

**YOU ARE SAFE**  
with

## THE TOLEDO TORCH

Note the sturdy, substantial construction. Rigid pressed steel with a cast iron weight welded into the bottom—it is always self-righting. No matter how it is kicked or tumbled about, like a cat it always lands right side up.

Nothing to break; so distinctive it will never be stolen. The use of

## THE TOLEDO TORCH

eliminates a big and constant item of expense.

Simple to operate, no glasses to clean. Just fill with kerosene and light. Put TOLEDO TORCHES around the open work or in the holes you leave. No hurricanes are needed.

No one can mistake the warning of this signal. Its ruddy flame is seen from a greater distance. It instantly attracts attention. The TOLEDO TORCH gives enough light to see all the danger.

Seven inches in diameter, holds seven-tenths of a gallon of kerosene. The TOLEDO TORCH will burn all night anywhere, at any time, in any kind of weather. It is an all-purpose danger signal.

Used by state and county highway departments, cities, public utilities, road builders and progressive contractors—everywhere. To them The Toledo Torch has proven the economical solution of a troublesome and expensive problem.



FIG. 4.



they produced a product which satisfied them. A reference to the Patent Office file on "chimneyless hydrocarbon burners," in which category the structure in suit is placed, would have revealed Wall, No. 228,497, a device undoubtedly superior to most of the structures shown on pages 271-287 of the record. But, as Judge Simons comments, "They chose the long road to solution."

Granting the truth of patentees' evidence that numerous different structures were attempted, very promptly upon their becoming aware of the fact that simple partial enclosure of the sides of the flame would not prevent rain from putting it out, they concluded that some sort of top was necessary. Their experience was completely paralleled by the Detroit Street Railways experimenter six years before.

As the Court suggested in *New York Scaffolding Co. v. Chain Belt Co.*, 254 U. S. 32, at pages 36-37 it is certain that the struggle through which these patentees went could not have caused them sleepless nights or laborious days. Patentees, like the inventor in the *New York Scaffolding Case*, were not experienced in the art in which they were attempting to make advances, forcibly demonstrated by the crude nature of their original experimental structures, and the comments of the Court in that case seem apt:

" \* \* \* But one is forced to think that where a change is readily made in a composite instrumentality, the change is not the prompting or the product of invention."

But, it is said that others likewise struggled to attain the achievement of the patent in suit. The Court below has commented in its opinion:

"Others worked unsuccessfully to solve the problem. The proof here \* \* \* showed widely-separate, unsuc-

cessful attempts. \* \* \* Unsuccessful efforts were made over a long period by men skilled in the art of burners. \* \* \* Unsuccessful attempts were made by competitors who had long been in the business of manufacturing and selling open flame torches."

We do not concede that if such were the case, it would necessarily negative the conclusion that only mechanical skill was here involved. But we submit on the record in the instant case that the inferences drawn by the Court below are entirely unsupported by any facts in the record.

In the Statement of the case, point "d," we have analyzed the evidence offered by respondent in support of its position, and it need not be repeated here, except in summary form.

Prior to or contemporaneously with the patentees, two persons attempted to design a torch which would not be snuffed in wind or rain.

The first, in point of time, was an employee of the Detroit Street Railways. Taking the three-wick, cast iron torch which that company had been using since 1913, sometime in 1922 he placed a flat shield, supported by a pin, over the three wicks. The experiment continued for about two years. It was abandoned, and no other attempts appear to have been made by the experimenter. This is not an instance of an effort by one skilled in the art, or of a manufacturer or competitor of respondent. If significant of anything, it indicates that the first concept which came to this unskilled investigator was that of putting a flat umbrella over the top of the flame.

The second attempt came after respondent's unprotected torch was on the market, in 1928, from a manufacturer which found it was losing some of its lantern business to the open flame torches. During a period of two years three

devices were produced, which were offered in evidence in Court, although others are said to have been tested. One of these devices would withstand a very high wind (R. 171, f. 511); in the rain it went out. The experimenter testified:

"It occurred to me that I might possibly put a flat shield over the top so that the rain would not get in the center of the wick, that is, that thought must have been in my mind, but I just didn't do it." (R. 175, f. 523.)

Can this individual be said to be a person skilled in the art? He claimed to be indulging in a continuous and extensive research (R. 169, f. 505); but he did not do that "which must have been in his mind" and which, had it been done, would have led him simultaneously along the trail of the patentees, first to a device somewhat like that shown on page 277 of the record, and subsequently, in all probability, to a device closely akin to that of the patent in suit. It is also highly significant that this experimenter was a licensee of respondent, required under terms of its license to support respondent in litigation (R. 173, f. 517).

It is respectfully submitted that to designate these two isolated efforts of inexperienced experimenters as

"Unsuccessful attempts \* \* \* by competitors who had been long in the business of manufacturing and selling open flame torches," (R. 450)

is unsound to the brink of absurdity.

A majority of the patent cases decided during the past two decades turn on the question of whether anything more than the skill of the mechanic was involved in devising the structure upon which a patent was issued. This is a question of fact (*Thompson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 447; *Keyes v. Grant*, 118 U. S. 25, 36)

and upon this subject the opinions of the experts may be considered (*Dunbar v. Meyers*, 94 U. S. 187).

It is the theory of the patent law that whether inventors knew of prior art structures or not, they are presumed to have designed their devices in view of all of the prior art. The question here involved is whether, in view of Russian patent to Malcov, No. 1163 of 1868, Wall's "mill-lamp" or "torch-lamp" of 1880, and the Rutz hood of 1914, any invention can be said to reside in the addition of a flame guard akin to that hood to the body of the McCloskey torch of 1925. This question was gone into in detail in cross examination of the petitioner's expert, Dr. Luckiesh, on the trial, and the following interrogation was given and answered:

"RXQ 350. It is your opinion that a man skilled in the art, who was seeking to produce a warning flare in a kerosene burner that would withstand gale velocities as high as forty miles an hour, if he knew of this gas burner of Rutz, that that would at once occur to him as being adaptable and usable for the purpose of producing that flare which would withstand gale velocities. Do you mean to testify to that?

"A. If he were consciously searching for something of the sort that you describe \* \* \* and he knew of Rutz \* \* \* that would occur to him automatically."  
(R. 129, ff. 386-387.)

This was the only direct evidence in the record on the point and no attempt was made by respondents to refute it.

If we assume that patentees were "consciously searching" for an efficacious flame guard, even though they did not know of the Rutz hood, so far as the record goes, they nevertheless produced the device of the patent in suit—very similar to Rutz—very promptly.



At about the same time, Currie of the Dietz Company was half-heartedly experimenting in an attempt to get something better than the open flame Toledo torch. He cannot be said to have been "consciously searching" for an efficacious device, because, on his own testimony, he did not do that which his experience told him he should have done, and that which, had he done it, would have solved the problem.

Another observation which may be pertinent is that the device of the patent in suit did not come as an answer to a long-felt want. No substantial market developed until three and one-half years or more after the patent issued, when the State of Iowa, leading the procession, required all trucks using its highways to carry three flares, and petitioner's heavy sales of more than 100,000 torches annually did not come until two years later, in 1935. The record further shows that the necessity of a protected torch has not yet penetrated to a very substantial user, the Detroit Street Railways, which still seems satisfied with its cast iron torch and three unprotected wicks.

A lame attempt to explain the hesitancy of the Detroit Street Railways to adopt the improved torch was made in the record, when respondent's witness on the point testified:

"(The protected torches) have never been used . . . because we have a torch designed to take care of our peculiar circumstances. The torch has got to be low enough to set down in the depth of the brick pavement." (R. 61, f. 181.)

Respondent makes such a torch (See record in Nos. 166, 167, page 181, Exhibit J1 A, "Model F" torch).

Under the reasoning of *De Forest Radio Corp. v. General Electric Co.*, 283 U. S. 664, and *Paramount-Public Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474, this

war not the filling of a long-felt want. When the alleged inventing was done, there was no public demand. That came long after the alleged inventive act. The device of the patent in suit, then, would seem to be nothing more than a natural development in the art.

In determining whether or not mechanical skill was involved in the production of the patented device, the Court should further consider that the assemblage of the patent in suit involved elements all admittedly old, whether from kindred arts or not. This was conceded by the Court below. The applicable principles are shown in *Thompson Spot Welder v. Ford Motor Co.*, 265 U. S. 445, 451; *Concrete Appliances Co. v. Gomery*, 269 U. S. 177, 185; *Powers-Kennedy etc. Corp. v. Concrete Mixing etc. Co.*, 282 U. S. 175, 186; *Carbice Corp. v. American Patent Development Corp.*, 283 U. S. 420, 421; *Altoona Public Theatres Corp. v. American Tri-Ergon Corp.*, 294 U. S. 477, 486, in all of which decisions devices involving an assemblage of known elements having known functions were considered and found to have required nothing more than mechanical skill.

That all of the concepts involved and all of the means employed in the patented structure were old is abundantly borne out by the record. Disregarding the operation of the fuel reservoir, wick tube and wick, which patentees were trying to improve, the supposed new concepts as outlined in the patent specification, with the record facts applicable thereto, may be classified as follows:

a. *Heat reflection.* The specification states: "Heating of the wick is facilitated by reflection of heat from the dome-shaped cap" (ll. 72-74).

This premise is fallacious. Dr. Luckiesh testified that after the device had been in operation a few minutes, the

dome-shaped cap would be sooted up and could not possibly reflect any appreciable amount of heat. Soot, or carbon black, is used for many scientific purposes because it reflects no appreciable amount of radiant energy (R. 77, QQ. 53, 56).

b. *Conduction.* From the specification we learn: "Heating of the wick is facilitated by conduction to wick-holding collars 12 and 6 from their supporting flanges" (ll. 75-76).

This feature was described in Dr. Luckiesh's book on Artificial Light, published in 1920, page 60 (R. 81), and is true "of every kerosene device that has a holder around it" (R. 80, Q. 71). See also *Carlton v. Bokee*, 17 Wall. 463, quoted above, and the description in the Malcov specification (R. 327-328, ff. 981-982).

c. *Quiescent air.* The specification states:

"Air inlet openings 10 being above the lower edge of the cap leaves a space within the cap and above the flange for comparatively quiescent air." (ll. 78-83).

Of this feature, petitioner's expert testified:

"It may be reasonably quiescent in the state of zero wind velocity, but it is inconceivable that you could describe that as a layer of quiescent air when there is any wind velocity above practically zero" (R. 78, Q. 59).

d. *Restriction of inlet ports.* The specification states:

"The quiescent layer of air in contact with the wick holder and restriction of inlet ports to admit to the wick and holder only such air as is needed for combustion . . ." (ll. 83-86).

Dr. Luckiesh testified: "In a wind, they would cease to function as air ports" (R. 88, Q. 103). Respondent's expert agreed in principle (R. 219, XQ. 132).

e. *Admission of air.* Of this, the specification says: "Sufficient cool outer air is supplied to the end portion of the wick through the ports 10 for securing a satisfactory flame \* \* \* (ll. 89-91).

Petitioner's expert testified:

"We found by test that (the air ports) did not supply enough air apparently at zero wind. That was responsible for the extremely low candle power. If they did not function at zero wind they are not needed for winds above it because the flame ports become air ports automatically" (R. 88, Q. 103).

Respondent's expert agreed in principle (R. 219, XQ. 130-133).

At zero wind, the patented device with the wick extension of one-eighth of an inch, recommended by respondent, over an hour period, under controlled conditions, produced an average of 0.047 foot candles (R. 408, Item 32), or less than one-tenth of the candles produced by a lighted match (R. 87, f. 260). Patentee Withrow admitted that the device did not work so well in calm weather (R. 35, f. 103).

f. *Decrease in oil consumption.* The specification states: "It has been found that with the above-described construction and arrangement, the oil consumption is materially decreased" (ll. 93-96).

The tests showed that at zero wind velocity a very low oil consumption was achieved (0.037 pounds per hour), but at a savage sacrifice of illumination. At average wind velocities, up to ten miles per hour, the flare with the flame guard consumes more fuel than the flare without (see



graph, R. 401). The observations of the testing engineers from an hour's test under each condition, in pounds of kerosene consumed per hour, were:

<i>Wind Velocity</i> <i>m. p. h.</i>	<i>Without Flame</i> <i>Guard</i>	<i>With Flame</i> <i>Guard</i>
1.75	0.135	0.172
4.50	0.193	0.255
8.50	0.239	0.340
14.00	0.429	0.303
Average	0.249	0.2675

This is the converse of the "material reduction" mentioned in the patent specification, or the fifty per cent. saving which the Court below erroneously assumed was the fact in reaching its decision.

Respondent sought to substantiate its claims by comparative tests between devices which were not comparable, and the unprotected flare it used, Exhibit 10, was not as satisfactory a torch as Exhibit 17, which immediately preceded the patented torch (R. 20, f. 60). In respondent's tests, it extended the wick of the unprotected torch an inch and a half, unnecessary according to petitioner's tests, which showed the most efficient height to be one-half inch (see graph, R. 397). This is corroborated by the Detroit Street Railways' practice, which has used the half-inch extension since 1913 (R. 58, f. 173). As the trial court pointed out: "It is common sense to realize that the longer the wicks are, the more oil will be consumed" (R. 48, f. 143).

g. *Protection from wind and rain.* The specification states: "Another outstanding advantage resides in reducing the liability of extinguishing the flame by high winds or rain" (ll. 98-100).

In the opinion of Judge Simons, this was all patentees produced. The concept that a hood with imperforate top, side flame openings and air ports would protect a flame from wind and rain was not original with patentees. Rutz understood it thoroughly and designed his hood-8 with this in mind, as early as 1914 (R. 393, f. 1177).

Thus nothing is left to patentees save the dubious honor of being the popularizers of the Rutz hood 8 as the flame guard for a highway warning signal. The fact that patentees were the first introducers or popularizers is not in itself significant, *Vandeburgh v. Truscon Steel Co.*, 261 U. S. 6, 15; *Textile Machine Works, Inc. v. Louis Hirsch Textile Machines*, 2nd Circuit, 87 F (2nd) 702, 705, affirmed 302 U. S. 490.

In the *Vandeburgh Case*, it was said, per Mr. Chief Justice Taft, at page 15:

"But it is insisted that Vandeburgh was the first to introduce into the field of concrete reinforcing the kerf and integral spur to clamp the spiral rod; \* \* \* It may be true that, in the field of reinforcing concrete, the kerf and spur had not been used before as Vandeburgh used it, but the kerf and spur were old in the art of kindred fields. They were old in metal-working art \* \* \*."

In the *Textile Machines Works Case*, affirmed by this Court in 302 U. S. 490, it was said, per Judge L. Hand, at page 705:

"It may be that the introducer, the popularizer, of a new and valuable variant, should gather the profits: perhaps any new use should be enough. But the law is not so; \* \* \*."

As a summation, all of the concepts and elements comprising the patented device were old and well-known when patentees entered the art. They should have come readily to the hands of any artisan who was "consciously searching" for a solution to the problem. Even with their tedious methods of "cut and try," as counsel has characterized their efforts, patentees very readily achieved the desired result.

#### IV.

The patent in suit is for a double or analogous use of the Rutz hood, and is void under the patent statute, since the Rutz hood can be employed without change for the purposes of the patent in suit.

The trial Court found that the Rutz hood 8 "may be employed without change for the purposes of the patent in suit" (R. 430, f. 1289).

Such being the evidence in the case, claims seeking to monopolize a new use for that structure are void.

This Court has followed this principle numerous times, the most applicable citations being *Aron v. Manhattan Railway Co.*, 132 U. S. 84; *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 493; *Grant v. Walter*, 148 U. S. 547, 556; *Miller v. Force*, 116 U. S. 22, 28; *Knapp v. Morss*, 150 U. S. 221, 227-228. This principle has been applied recently in the Second Circuit in *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F (2nd) 823; *Ingersoll Rand Co. v. Worthington etc. Co.*, 87 F (2nd) 320.

The instant case presents the strongest factual basis within the principles of the above cases that has yet been submitted to this Court. It has been demonstrated conclusively that the Rutz hood 8 can be used without change for the purposes of the patent in suit. In the Statement

of the case, we have alluded to the qualification of a set of hares, using the Rutz hood as a flame guard, in the State of Nebraska. One of respondent's witnesses testified that this was one of the most difficult states in which to obtain a qualification (R. 52, f. 156). Photographs of the devices which qualified are shown on pages 414, 416 of the record, and as Figures 1 and 2 on pages 59 and 11 of this brief.

In *Aron v. Manhattan Railway Co.*, 132 U. S. 84, where railway car gates were in question, Mr. Justice Matthews pointed out the rarity of cases in which a prior art device can be used *without any actual change*, saying:

"It rarely happens that old instrumentalities are so perfectly adapted for a use for which they were not originally intended as not to require any alteration or modification. If these changes involve only the exercise of ordinary mechanical skill, they do not sanction a patent; and, in most of the adjudged cases where it has been held that the application of an old device to a new use was not patentable there were changes of form, proportion or organization of this character which were necessary to accomodate them to the new occasion."

The record presents, however, one of those rare instances in which no changes whatsoever in "form, proportion or organization," are necessary.

The fact that the prior art device had never been used in the same environment as that disclosed in the patent was considered in *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 493, which involved a patent on an internal toothed gear for windmills. It was said, per Mr. Justice Brown:

"Martin, therefore, discovered no new function; and he created no new situation, except in the limited sense



that he first applied an internal gearing to the old Mast-Foos mill, which was practically identical with the Martin patent, except in the use of an internal gearing. He invented no new device; he used it for no new purpose; he applied it to no new machine. All he did was to apply it to a new purpose in a machine where it had not before been used *for that purpose.*"

In the instant case, the respondent's torch body "is practically identical with the (McCloskey patent R. 388) except in the use of (a flame guard)."

That utility alone is insufficient was the holding in *Grant v. Walter*, 148 U. S. 547, a case involving the validity of a patent on a silk winding reel. In discussing this point, the Court said, per Mr. Justice Jackson, at page 556:

"The most that can be said of this Grant patent is that it is a discovery of a new use for an old device which does not involve patentability. \* \* \* The advantages claimed for it, and which no doubt it possesses to a considerable degree, cannot be held to change this result, it being well settled that utility cannot control the language of the statute which limits the benefit of the patent laws to things which are *new* as well as *useful.*" (Italics ours.)

The principle applied in the cited case clearly nullifies any advantage which respondents seek to gain from the fact that they have produced a useful device.

Nor is the fact that they were the first to contemplate this use significant. In *Miller v. Force*, 116 U. S. 22, a case involving a patent on tobacco plugs, it was said, per Mr. Justice Bradley, at page 28:

"The application of an old process or machine to a similar or analogous subject, with no change in the

manner of applying it and no result substantially distinct in its nature, will not sustain a patent, even if the new form or result has not before been contemplated."

What patentees are attempting to effect is a monopoly in the use of the Rutz hood 8 as a flame guard for highway warning signals, but it is the device alone which can be patented, and not its use. This was clearly pointed out in *Knapp v. Morss*, 150 U. S. 221, a case involving the patentability of an adjustable dress form, where it was said, per Mr. Justice Jackson, at pages 227-228:

" \* \* \* But it is well settled by the authorities that the end or purpose sought to be accomplished by a device is not the subject of a patent. The invention covered thereby must consist of new and useful means of obtaining that end. In other words, the subject of the patent is a device or mechanical means by which the desired result is to be secured. (Citations omitted.) Tested by these authorities, the validity of the patent in question must be ascertained, not from a consideration of the purposes sought to be accomplished, but of the means pointed out for the attainment thereof, and if such means, adapted to effect the desired result, do not involve invention, they can derive no aid or support from the end which was sought to be secured. All that Hall did was to adapt the application of old devices to a new use. \* \* \*"

Petitioner's expert testified on this very point, that if the Rutz hood 8 were transferred to a torch body: "All the principles of operation would remain the same." (R. 127. RDQ 339.)

We have already quoted the trial Court's finding on this point. The Circuit Court argued that even though the Rutz apparatus would accomplish the functions and results of the patent in suit, the patented structure must be considered as an entirety, and that as Rutz had never been used in combination with a torch body to produce the result of the patent in suit, respondent was entitled to a patent thereon. Such a holding clearly does not square with the principles just referred to, and cannot be substantiated under either the facts or the law.

Respondent has heretofore argued that such cases as *Potts v. Creager*, 155 U. S. 597; *National Cash Register Co. v. Boston Cash Indicator*, 156 U. S. 502; and *Hobbs v. Beach*, 180 U. S. 383, justify sustaining the validity of the patent in suit.

None of the cases which they cite, and others similar in principle which may be found in the decisions of this Court, can be applied to the instant case. In no instance can the prior art devices referred to in those cases actually be used without change for the purposes of the patent. The facts of *Hobbs v. Beach*, 180 U. S. 383, are typical. The question concerned the validity of a patent on an automatic box-making machine. The closest anticipation was a certain machine known as the Dennis and York Machine, used in the prior art for pasting labels on newspapers. Of this, it was said, per Mr. Justice Brown, at pages 392, 393:

"By changing the flat head and flat platen to clamping dies with diverging faces, and strengthening and changing the machine in some minor particulars, it could be used to fasten stay-strips to box-corners. Indeed, a model of the Dennis and York Machine so altered, was put in evidence, and shown to be capable of doing the work of the Beach patent, though somewhat crudely and imperfectly. • • •"

Such a case has clearly no applicability to the instant case. *The Rutz hood 8 requires no alteration whatsoever. Instead of doing the work "crudely and imperfectly," it meets every requirement of very rigid state laboratory tests. And in its use either on a gas stove or on a highway flare, it was first and last a flame guard.*

The Court below refers to *Rockwood v. General Fire Extinguisher Co.*, 2nd Circuit, 8 F (2nd) 682, in which it held valid a dry pipe valve for a sprinkler system. Defendant in that case owned a certain Crosby patent which it claimed anticipated. By eliminating a vacuum element, the Crosby patent could be made to function similarly to the patent in suit. The Court, however, pointed out, page 686, per Judge Manton:

"The tests made prove that the Crosby valve without the vacuum was inoperative fifty per cent. of the time. The appellant's valve has never failed and has a record of one hundred per cent. Therefore, even modifying the apparatus of Crosby, it was not a successful device, and would not be capable of commercial use for fire extinguishing."

Thus the authority relied on by the Court below is really an authority in favor of petitioner. The Rutz device, without change, will qualify in one of the most difficult states, Nebraska. Its performance, like that of the device of the patent, is one hundred per cent. according to testing standards.

Nor does the fact that the Rutz hood 8 was used to protect the flame on a gas stove require us to consider the analogy of the arts here involved, although that hood and the dome-shaped cap of the patent in suit are both structures in the art of protecting flames from being extinguished. It was pointed out in the Second Circuit case of



*Swright & Lloyd Sintering Co. v. Greenawalt*, 27 F (2nd) 823, per Judge L. Hand:

"The use for which the apparatus was intended is irrelevant if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses."

### V.

If it be the holding of the Court that the Rutz hood does not anticipate claims 11 and 12, then petitioner's device does not infringe, since it is using the Rutz hood in its device.

It was found by the trial Court that petitioner was using a flame guard similar to one manufactured by the Milwaukee Gas Specialty Company (owners of the Rutz patent), except as to the size of the flame ports, and the Court further found that the difference between petitioner's structure and the Rutz structure in the size of the flame ports was immaterial (R. 430, Finding 7).

Petitioner adopted this type of flame guard about July, 1934, and it has been using it ever since. It is not disputed that this structure is adequate to meet all of the rigid requirements of the various state testing laboratories. The trial Court's finding on this subject was not disturbed by the Circuit Court of Appeals.

The facts here set out justify the application of the well-known axiom: "That which does not anticipate cannot infringe," in the event the Court should be of the opinion that the Rutz hood 8 does not anticipate claims 11 and 12 of the patent in suit.

Cases in which this axiom was applied are *Peters v. Active Mfg. Co.*, 129 U. S. 530; *Grant v. Walter*, 148 U. S. 347, 553, 556; *Knapp v. Morss*, 150 U. S. 221, 226; *American Fruit Growers, Inc. v. Brodger Co.*, 283 U. S. 1.

The anomaly of the situation would be clearly brought forth in a theoretical suit by respondent against the Milwaukee Gas Specialty Company, which has been manufacturing and selling the Rutz hood since 1914. Three of these hoods were furnished by the Milwaukee Gas Specialty Company, placed on torch bodies, and submitted to the State of Nebraska for qualification. This constituted a use. Claims 11 and 12 refer to the flame guard alone, and the Milwaukee Gas Specialty Company's product was being used as "a burner for a construction torch adapted to emit luminescent flame."

Were it supposed that the Milwaukee Gas Specialty Company, having the necessary dies and other equipment, decided to manufacture torches using its hood, can one think for a moment that it would be guilty of infringement of the patent in suit? Such a supposition strains one's sense of proportion, yet it is the one which the Court below sanctioned, since the finding of the trial Court that petitioner was using the Rutz hood was not disturbed.

The axiom which we here seek to apply is founded upon the social necessity of protecting conscientious manufacturers who utilize the prior arts. In the majority of patent cases, the Court finds the defendant extolling the virtues of the prior art, while it uses the patented structure. Such a case is *Rockwood v. General Fire Extinguisher Co.*, 2nd Circuit, 8 F (2nd) 682, relied on by the Court below, in which the defendant claimed a certain Crosby patent which it had owned but not used for twenty-two years, anticipated. Such is not the instant case. The petitioner's manufacturer believes sufficiently in the efficacy of the prior art structure upon which it relies to use it, and it has been doing so for almost five years.

## VI.

Infringement can be found only through a departure from the theory of the specification and by construing the claims to extend beyond the invention; as construed by the Court below the claims are clearly void.

In considering the question of infringement, which in the instant case is inextricably bound with the question of validity under the prior art, the Court's premise was:

"No statement in the claims or specifications requires that the cap rest directly on the body of the torch nor that the air inlet ports be located in the body of the cap."

Petitioner justifies its argument of non-infringement upon the proposition that it has raised its flame guard above the top base of the torch body and placed its air ports in a horizontal flange below the cap, whereas every suggestion of the patent and the claims, if read carefully, is that the flame guard be mounted on the top base of the torch body and that the air inlet ports be vertically positioned in the side of the cap.

Petitioner's method is the sensible way to design the structure because it results in an upward draft of air, by reason whereof petitioner obtains a much better performance than respondent at a very low wind velocity. It was admitted by one of the patentees that respondent's device did not work so well in calm weather (R. 35, f. 103) and the reasons for this were pointed out by Dr. Luckiesh in his statement that "air does not like to turn sharp corners" (R. 91, Q 133), which it would have to do to function at low wind velocities in respondent's structure.

The structural differences are therefore significant, from the point of view of performance, and in holding that they

had no significance on the question of infringement, the Court below permitted respondent to depart from the theory put forth by its patentees in the patent specification.

The specification states (p. 1, ll. 78-87):

"Air inlet openings 10 *being above the lower edge of the cap* leaves a space within the cap *and above the flange* of the wick holder for comparatively quiescent air. This quiescent layer of air in contact with the wick holder and the restriction of inlet ports to admit to the wick and holder only such air as is needed for combustion aids in maintaining the heat of the wick holder and wick." (Italics ours).

If the device is to operate as patentees have described it, the air inlet ports must be *above the edge of the cap*. They are not so positioned in petitioner's structure.

In the recent case of *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. ...., Nos. 3-5 October term, 1938, decided November 7, 1938, well-recognized principles, which were overlooked by the Court below, were again stated by Mr. Justice Stone:

"The object of the statute is to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and 'to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license, and which may not'. *Permutit Co. v. Graver Corp.*, 248 U. S. 52, 60. It follows that the patent monopoly does not extend beyond the invention described and explained as the statute requires, *Permutit Co. v. Graver Corp.*, *supra*. That it cannot be enlarged by claims in the patent not sup-



ported by the description, *Snow v. Lake Shore M. S. R. Co.*, 121 U. S. 617, cf. *Smith v. Snow*, 294 U. S. 1 \* \* \*."

In the case of *Snow v. Lake Shore M. S. R. Co.*, 121 U. S. 617, quoted by Mr. Justice Stone, it was said, per Mr. Justice Matthews, at page 630:

"On this appeal, it is argued, \* \* \* that this construction of their patent is too narrow; and it is now contended that the detachment of the piston and piston rod is not an essential part of the description and claims of the invention patented. We cannot, however, but agree with the Circuit Judge, that the language of the specification limits the first claim to a combination in which the piston and piston rod are detached from each other \* \* \*

"It is not admissible to adopt the argument made on behalf of appellants, that this language is taken as a mere recommendation by the patentee of the manner in which he prefers to arrange these parts of his machine. *There is nothing in the context to indicate that the patentee contemplated any alternative for the arrangement of the piston and piston rod \* \* \**" (Italics ours.)

So, in the instant case, there is nothing in the patent specification whatsoever suggesting "any alternative" for the positioning of the air inlet openings above the edge of the cap to permit the existence within the cap and above the flange of a layer of comparatively quiescent air. There is no suggestion anywhere in the patent that the structure can operate without this layer of quiescent air. It is equally clear that by reason of the different positioning of the air inlet ports in petitioner's structure, the latter cannot contain any such feature.

The principles expressed in *Mackay Radio & Tel. Co., Inc. v. Radio Corp.* .... U. S. ..., decided January 30, 1939, are also applicable. Respondent has attempted "to broaden the only invention described in the application" by rejecting its theory that the air inlet ports must be in the side walls of the cap and above the flange to create the layer of comparatively quiescent air.

That it is bound by the theory of the specification is shown in the Second Circuit case of *St. Pierre v. Redpatch etc. Co.*, 87 F (2nd) 766, involving an anti-skid strap for a tire, which, the specification said, should be drawn as tightly as possible around the tire. It was said, per Judge Manton, at page 767:

"(The inventor) cannot now state that his commercial unit is applied loosely to the wheel and claim this as a patentable feature of his invention, *since it is inconsistent with his patent description.*" (Italics ours.)

Equally is the omission of "a "layer of comparatively quiescent air" inconsistent with the description of the instant patent.

The Court below likewise relies upon the statement in the specification that the description "is by way of illustration and not of limitation," to give the claims breadth. This is the trite phrase found in most patent specifications. If it has any effect, it is as a claim to equivalents, and the Rutz hood 8 being a known equivalent, such a claim would nullify the patent.

A preferable alternative is to indulge the presumption that patentees designed their flame guard, mounted on the top base of the torch body with air inlets in the side walls and a layer of comparatively quiescent air, in the light of the Rutz hood 8 in an attempt to escape the necessary invalidity of their patent which the prior existence of the

Rutz hood 8 requires. The presumption is not a violent one since 15,000,000 of the Rutz hoods went into public use.

But respondent, in its grasp for a monopoly, wants all-inclusive coverage, even to the extent of stretching its claims to the breaking point.

## VII.

### CONCLUSION.

As a summary, all that patentees did was add a flame guard to McCloskey's open flame torch which it had been manufacturing. Their purpose was to protect the open flame of the McCloskey burner from wind and weather.

Except in periods of high winds, the open flame torch was more efficient as a highway warning signal than respondent's device. In a high wind, the protected torch burns with a blue flame—not the luminescent flame of the patent claims—and is of little value as a warning signal (R. 215, XQQ 82, 84). (This undoubtedly accounts for the low candle readings at fourteen miles per hour and more [see graph, Fig. 37, R. 403]. The readings at fourteen miles per hour with and without flame guard were 1.82 and 1.02 foot candles, respectively, and with flame guard at 25.6 miles per hour, 0.22 foot candles; at 4.73 miles per hour respondent's device with flame guard developed 10.22 foot candles, R. 408, Items, 23, 24, 25 and 44).

Under such circumstances, the flame guard's only value is to keep the flame lit until the wind abates. Under all conditions, the cap, like any umbrella, tends to prevent a deluge from drowning the flame.

The art of protecting open flames from wind or weather is as old as civilization, as the Court will see from the record, and must know from the lamp and hydrocarbon

burner art. As we have shown, the Butz hood 8 met all the problems before patentees became interested in the torch industry, and it can be substituted without change for respondent's structure, accomplishing the identical purpose with entire efficiency.

Giving to patentees the most favorable view of their patent, the alleged invention consisted in taking from the well-known gas burner art a structure the purpose of which was to protect an open flame from extinguishment by currents of air and falling liquids, and combining this structure with the well-known McCloskey torch.

No such development has ever been recognized by this Court as rising to the dignity of an invention entitled to the monopoly given by the patent law.

All of which is respectfully submitted.

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